UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/327,744	10/24/94	STONE M	3309P-65

EXAMINER	
GOODMAN, C.	
ART UNIT	**PAPER NUMBER**
3724	31

DATE MAILED: 04/10/01

QM32/0410

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Notification of Non-Compliance With 37 CFR 1.192(c)	Application No. 08/327,744	Applicant(s) STONE ET AL.	
	Examiner Charles Goodman	Art Unit 3724	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on *1/25/01* is defective for failure to comply with one or more provisions of 37 CFR 1.192(c). See MPEP § 1206.

To avoid dismissal of the appeal, applicant must file IN TRIPLICATE a complete new brief in compliance with 37 CFR 1.192 (c) within the longest of any of the following three **TIME PERIODS**: (1)**ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer; (2) **TWO MONTHS** from the date of the notice of appeal; or (3) within the period for reply to the action from which this appeal was taken. **EXTENTIONS OF THESE TIME PERIODS MAY BE GRANTED UNDER 37 CFR 1.136.**

1. ☐ The brief does not contain the items required under 37 CFR 1.192(c), or the items are not under the proper heading or in the proper order.

2. ☐ The brief does not contain a statement of the status of all claims, pending or cancelled, or does not identify the appealed claims (37 CFR 1.192(c)(3)).

3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 1.192(c)(4)).

4. ☐ The brief does not contain a concise explanation of the claimed invention, referring to the specification by page and line number and to the drawing, if any, by reference characters (37 CFR 1.192(c)(5)).

5. ☐ The brief does not contain a concise statement of the issues presented for review (37 CFR 1.192(c)(6)).

6. ☐ A single ground of rejection has been applied to two or more claims in this application, and

   (a) ☐ the brief omits the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet presents arguments in support thereof in the argument section of the brief.

   (b) ☐ the brief includes the statement required by 37 CFR 1.192(c) (7) that one or more claims do not stand or fall together, yet does not present arguments in support thereof in the argument section of the brief.

7. ☐ The brief does not present an argument under a separate heading for each issue on appeal (37 CFR 1.192(c)(8)).

8. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 1.192(c)(9)).

9. ☒ Other (including any explanation in support of the above items):

   See Continuation Sheet ATTACHED

Charles Goodman
Examiner
Art Unit: 3724

Re Notice of Non-Compliance With 37 CFR 1.192(c)

1. Receipt is acknowledged of the Appeal Brief filed on January 25, 2001. Upon review of the Brief, it appears that the Examiner erred in not responding to the Appellant's submission of the Declaration under 37 CFR 1.132 filed on November 16, 2000. This is greatly regretted. However, to reduce the issues on appeal, the Examiner will respond to the declaration in the following. Based upon the Examiner's response, the Appellant is requested to respond in any manner the Appellant deems appropriate. For example, the Examiner believes that the Examiner's response will obviate the issue of whether or not the Examiner erred in not responding to the declaration. Thus, a subsequent Appeal Brief should be filed corresponding to this issue being resolved in one way or another.

2. The declaration under 37 CFR 1.132 filed on November 16, 2000 is insufficient to overcome the rejection of claims 1-8 based upon McComas in view of Shiembob, Ryan, or Ackerman as set forth in the last Office action because: the showing is not commensurate in scope with the claims.

First, it is noted that Mr. Clifford V. Mitchell (declarant), is one of the named inventors of the instant application. Due to this fact, these statements are less persuasive than that of a disinterested person, but the weight thereof will not be disregarded for this reason alone. *Ex parte Keyes*, 214 USPQ 579 (Bd. App. 1982); *In re McKenna*, 203 F.2d 717, 97 USPQ 348 (CCPA 1953). It is also noted that although factual evidence is preferable to opinion testimony, such testimony is entitled to consideration and some weight so long as the opinion is not on the ultimate legal

conclusion at issue. While an opinion as to a legal conclusion is not entitled to any weight, the underlying basis for the opinion may be persuasive. *In re Chilowsky*, 306 F.2d 908, 134 USPQ 515 (CCPA 1962); *In re Lindell*, 385 F.2d 453, 155 USPQ 521 (CCPA 1967). Therefore, the probative value of declarant's statements are limited to the underlying basis for the opinion.

Second, declarant asserts that a honeycomb metal structure is different from spray and sintered coatings as in McComas, and the declarant further asserts that the methods employed to remove this coating is different from that of the metal honeycomb.[1] However, this is not germane to the claims at bar. The claims do not require the honeycomb structure to be metal. Thus, it is irrelevant. Moreover, the claims were not rejected under McComas alone but also under a plurality of different references which individually combined with McComas rendered the claimed invention obvious. In addition, the Examiner also pointed out in the rejection of the claims that McComas teaches a liquid jet erosion method which encompasses removal of abradable seals used in gas turbine engines. The declarant did not touch on this point. Therefore, declarant's comments that the removal methods for the spray and sintered coatings are not generally applicable to metal honeycomb fails to persuade.

Third, the declarant discusses to some extent the process the declarant was involved in obtaining the present method to overcome a long felt need.[2] However, they include statements which amount to an affirmation that the claimed subject matter functions as it was intended to function. This is not relevant to the issue of

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[1] Declaration, ¶ 2.
[2] *Id.*, ¶¶ 3-6.

nonobviousness of the claimed subject matter and provides no objective evidence thereof. See MPEP § 716. In addition, the declarant fails to establish that the long-felt need have not been satisfied by another before the invention by the Applicant. *Newell Companies v. Kenney Mfg. Co.*, 864 F.2d 757, 768, 9 USPQ2d 1417, 1426 (Fed. Cir. 1988). The declarant identifies the long-felt need as basically a honeycomb removal process that does not damage the substrate. In that regard, McComas already teaches a method that perform substantially the same except that it is in reference to the coating on the substrate. However, as the Examiner noted above, McComas also teaches that the method may be applied on abradable seals in turbine engines. The claimed honeycomb is an abradable seal. Therefore, McComas provides sufficient evidence that the long-felt need had been satisfied prior to the Applicant. Lastly, the alleged failure to solve the long-felt need may be due to factors such as lack of interest or marketability rather than want of technical know-how. *Scully Signal Co. v. Electronics Corp. of America*, 570 F.2d 355, 196 USPQ 657 (1st. Cir. 1977).

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Goodman whose telephone number is (703) 308-0501. The examiner can normally be reached on Monday-Thursday between 7:30 AM to 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, can be reached on (703) 308-2187. The fax phone number for this Group is (703) 305-3579.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [**rinaldi.rada@uspto.gov**].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

Charles Goodman
Patent Examiner
AU 3724

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April 9, 2001